

REMARKS

In the Office Action dated April 9, 2003, claims 3, 4, 6, 8, 10-17 and 19-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tanaka in view of Kroener and Burke et al. and Deucher et al.

Claims 16, 19 and 21 had been previously stated to be allowable if rewritten in independent form, however, the previously-indicated allowability of claims 16, 19 and 21 was withdrawn in view of the newly cited Burke et al. reference. Nevertheless, Applicants believe that the subject matter of claims 16, 19 and 21 is not disclosed or suggested in the Burke et al. reference, for the reasons discussed below. Therefore, independent claim 8 has been amended by bringing the subject matter of claim 16 therein, independent claim 17 has been amended by bringing the subject matter of claim 19 therein, and independent claim 20 has been amended by bringing the subject matter of claim 21 therein. Claims 16, 19 and 21 accordingly have been cancelled.

In substantiating the rejection of claims 16, 19 and 21 in paragraph 12 at page 8 of the Office Action, the Examiner acknowledged that the Tanaka reference does not disclose a first heat exchanger that is rotatable to generate an airstream guided by a plurality of inter-engaging annular guide devices. The Examiner relied on the Deucher et al. reference as teaching a first heat exchanger that is rotatable to generate an airstream guided by an annular guide device, citing column 5, lines 9-24 of Deucher et al., and the Examiner further relied on the Burke et al. reference as teaching a plurality of inter-engaging annular guide devices, citing Figure 4 of the Burke et al. reference.

The Examiner stated it would have been obvious to a person of ordinary skill in the art to have the rotatable heat exchanger generate air guided by an annular device of Deucher et al. with the suggested device of Tanaka in view of Kroener, Burke et al. and Deucher et al., since such a person would be motivated to use it to remove excess heat which may cause damage, as implied from Deucher et al. at column 5, lines 10-25. The Examiner further stated it would have been obvious to one of ordinary skill in the art to have a plurality of inter-engaging annular devices of Burke et al. with the suggested device of Tanaka in view of Kroener, Burke et al. and Deucher et al., since one would be motivated to use it to remove excess heat by conducting a tortuous air flow and conserve space, as implied by Burke et al., column 5, lines 50-60.

Applicants respectfully submit that the manner by which the Examiner has substantiated the rejection of the subject matter of previous claims 16, 19 and 21 is evidence of the non-obviousness of the subject matter of those claims, rather than the obviousness thereof. The Examiner has separated out the two significant features of those claims, namely the use of a rotatable heat exchanger to generate air guide by annular guide devices, and forming those annular guide devices as inter-engaging annular guide devices. The Examiner has relied on separate and independent teachings from the Deucher et al. and Burke et al. references, and identified separate and independent motivations for making each of those modifications to the basic structure relied upon by the Examiner.

The subject matter now embodied in independent claims 8, 17 and 20, however, is an overall *combination*, and it is not permissible to assess the patentability of such a combination by piecemeal identification of different teachings

from different references, with separate motivations being supplied for making a modification to the basic structure based on each of those references. The overall combination of a claim must be viewed as a whole, and there must be a persuasive motivation for making the entire combination, rather than separate motivations for making one modification, then another modification, etc.

The Deucher et al. reference does, in fact, disclose annular guide devices to conduct air from a first heat exchanger, however, the Deucher et al. reference does not disclose or suggest that such annular guide devices should be inter-engaging annular guide devices. The Burke et al. reference discloses inter-engaging annular heat exchangers. The purpose of inter-engagement of the heat exchangers in the Burke et al. reference evidently is to increase the surface areas of both heat exchangers in order to facilitate heat exchange therebetween. Burke et al., however, does not disclose or suggest the user of inter-engaging annular guide devices. As can be seen from Figure 4 of the Burke et al. reference, cited by the Examiner, the inter-engaging annular heat exchangers in the Burke et al. reference cannot be provided with annular guide devices of the type described in the Deucher et al. reference, due to a lack of space. A person of ordinary skill in the art who has not had the benefit of first reading the present disclosure, therefore, would look at Figure 4 of the Burke et al. reference and be deterred from incorporating annular guide devices therein, due to the obvious lack of space in the structure disclosed in the Burke et al. reference. Only the present inventors have had the insight to devise a structure which not only provides for annular guide devices, but allows those guide devices to be inter-engaging. No such structure is disclosed or suggested in the references of record.

Applicants recognize that in order to support a rejection under 35 U.S.C. §103(a), it is not necessary that the references that are relied upon be physically combinable with each other. Nevertheless, it is still incumbent on the Examiner to propose a structure which has some realistic hope of being built, otherwise the proposed combination is merely theoretical, or falls in the category of "obvious to try" which, as many decisions from the Board of Patent Appeals and Interferences and the Federal Circuit have stated, is not a proper basis for substantiating a rejection under 35 U.S.C. §103(a). Given the complete absence of any "extra" space in the structure shown in Figure 4 of the Burke et al. reference, Applicants respectfully submit that it is incumbent on the Examiner to at least propose how or why a person of ordinary skill in the art would believe that such a structure could be further accommodated with annular guide devices. Applicants respectfully that a person of ordinary skill in the art would not even consider attempting to incorporate annular guide devices in the structure shown in Figure 4 of Burke et al., due to the aforementioned lack of space. Nevertheless, even if a person of ordinary skill in the art, for reasons unknown to the present Applicants, would make an attempt to do so, this necessarily would result in a complete redesign of the Burke et al. structure, rather than a simple modification thereof, and as such would be a non-obvious modification.

The claims which remain in the application that depend from claim 8 add further structure to the non-obvious combination of claim 8, and are therefore patentable over the above references for the same reasons discussed above in connection with claim 8.

All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

Submitted by,

Steven H. Noll

(Reg. 28,982)

SCHIFF, HARDIN & WAITE

CUSTOMER NO. 26574

Patent Department

6600 Sears Tower

233 South Wacker Drive

Chicago, Illinois 60606

Telephone: 312/258-5790

Attorneys for Applicants.

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